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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------|------------------|
| 09/686,849 | 10/10/2000 | Michael Dean Whitmarsh | 10003976-1 | 5548 |
| 7590 | 01/07/2005 | | EXAMINER | |
| HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400 | | | WALLERSON, MARK E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2626 | |
| DATE MAILED: 01/07/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/686,849 | Applicant(s) WHITMARSH ET AL. |
|------------------------------|-------------------------------|----------------------------------|
| | Examiner Mark E. Wallerson | Art Unit 2626 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 17 August 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-15 and 17-43 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-15 and 17-43 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 8/17/04.
2. This application has been reconsidered. Claims 1-15 and 17-43 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hower (U.S. 5,467,434) in view of Maruta et al (Maruta) (U.S. 6,064,838).

With respect to claims 1, 2, 3, 4, 6, 9, 10, 11, 14, 15, 18, 19, 20, 21, 24, 26, 29, 30, 31, 36, 37, 38, 39, and 42, Hower discloses a method of brokering a print job comprising the steps of providing a print brokering system controller (25, figure 2) having a printing capability of each of a plurality of print providers (12) provided therein (column 4, lines 28-40); defining a network communication link between the customer and the print brokering system controller (figure 2 and column 3, lines 63-66); comparing a print request for the print job with the printing capability of each of the print providers and determining which of the print providers have the capability to fulfill the print request (column 6, lines 20-47), and compiling a list of at least one of the print providers which has the printing capability to fulfill the print request (column 4, lines 28-37 and the abstract).

Hower differs from claims 1, 2, 3, 4, 6, 9, 10, 11, 14, 15, 18, 19, 20, 21, 24, 26, 29, 30, 31, 36, 37, 38, 39, and 42 and in particular claims 1, 19, 37, and 38 in that although he discloses composing a list of print providers which have the capability of fulfilling the print request (column 4, lines 28-37 and the abstract), he does not clearly disclose presenting the list to the customer, the list excluding print providers which do not have the printing capability to fulfill the print request.

Maruta discloses a printing system wherein a list of print providers (3) capable of fulfilling a print request (satisfying desired print conditions) are provided to a user (column 18, lines 26-45), the list excluding print providers which do not have the printing capability to fulfill the print request (which reads on the print information sent to the user side data processor includes information on the ability of the copy machine **with respect to the copy machine that can print out the image file** according to the [requested] print condition (emphasis added) (column 18, lines 31-37). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Hower to present the list to the customer, the list excluding print providers which do not have the printing capability to fulfill the print request. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Hower by the teaching of Maruta in order to improve the efficiency of the printing system.

With regard to claims 5, 22, 23, and 40, Hower discloses registering the printing capability includes registering the print medium capability (column 5, lines 13-29).

With respect to claim 7, Hower discloses submitting the print request for the print job to the print brokering system via the network (column 3, line 63 to column 4, line 12).

With regard to claims 8, 27, 28, and 41, Hower discloses submitting the print request includes specifying a finishing option (column 4, lines 2-12).

With respect to claims 12, 32, and 43, Hower discloses the performance capability includes an availability to complete the job (column 5, lines 22-24).

With respect to claims 13, 33, and 34, Hower discloses ranking the print providers based on the performance attributes (column 8, lines 54-66 and column 9, lines 2-12).

With regard to claim 35, Hower discloses providing the list of print providers to the customer (column 3, lines 59-66).

With respect to claim 25, Hower discloses a customer interface to transmit the print request to the print brokering system controller (column 3, lines 50-66).

Response to Arguments

5. Applicant's arguments with respect to claims 1-15 and 17-43 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE** MONTHS from the mailing date of this action. In the event a first reply is filed within **TWO**

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (703) 305-8581. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197-(toll-free).

Mark E. Wallerson
Primary Examiner
Art Unit 2626

MARK WALLERSON
PRIMARY EXAMINER